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IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application Serial No. 76/301162
Filed on August 17, 2001
For the mark "EXEL"
Published in the Official Gazette on November 19, 2002 at Page TM 452



01-27-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #70

EDMONT P. D'ASCOLI, TRUSTEE OF)
THE EDMONT P. D'ASCOLI REVOCABLE)
LIVING TRUST DATED MAY 24, 1996)

Opposer,)

v.)

EXEL OYJ)

Applicant.)

Opposition No.: _____

02/04/2003 K6IBBONS 00000058 76301162

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300.00 OP

NOTICE OF OPPOSITION

EDMONT P. D'ASCOLI, Trustee of the EDMONT P. D'ASCOLI REVOCABLE LIVING TRUST DATED MAY 24, 1996 ("**Opposer**"), whose mailing address is 66-590 Kamehameha Highway, Haleiwa, Hawaii 96712, believes he will be damaged by the registration of the mark "EXEL" shown in Application Serial No. 76/301162 in the name of EXEL OYJ ("**Applicant**") for clothing items in International Class 25 (the "**Application**") and hereby opposes the Application on the following grounds:

1. Applicant seeks to register "EXEL" as a trademark in connection with "clothing; namely, pants, shirts, t-shirts, shorts, sweatshirts, jackets, gloves, hats, socks and headwear" in International Class 25.

2. The Application was filed on August 17, 2001.

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3. Opposer owns the following U.S. Trademark Registrations for his mark, "XCEL": (1) Registration No. 1,965,081 covering "wetsuits, swimwear, t-shirts, sweat shirts, sweat pants, jerseys, jackets, shirts, shorts, headwear, footwear, namely, surf bootees and dive bootees" in International Class 25; (2) Registration No. 1,622,623 covering "bathing suits and bicycling apparel, namely, shirts, tights, jackets, jerseys, shorts, hats" in International Class 25; (3) Registration No. 1,292,982 covering "wetsuits" in International Class 25; and (4) Registration No. 2,217,115 covering "retail stores featuring wetsuits, swimsuits and watersport related goods" in International Class 35.

4. Opposer's registrations are valid and subsisting and remain in full force and effect, as evidence of the validity, and of Opposer's exclusive ownership of, and the right to use, "XCEL", or any mark confusingly similar thereto, or which causes the dilution thereof, for goods and services covered by the registrations or substantially-related thereto.

5. Opposer's registrations 1,292,982, 1,622,623 and 1,965,081 have become "incontestable" under Section 15 of the Lanham Act, 15 U.S.C. § 1065.

6. For many years, Opposer has advertised, sold and distributed his goods and services listed in the aforesaid registrations under his mark "XCEL" throughout the United States and the world. Opposer has developed an exceedingly valuable good-will with respect to his mark "XCEL".

7. By virtue of his efforts, the expenditure of considerable sums for advertising and promotional activities, and by virtue of the excellence of his products and services, Opposer has gained for his mark "XCEL" a most valuable reputation.

8. Opposer's mark "XCEL" is famous under 15 U.S.C. § 1125(c)(1).

9. Opposer's mark "XCEL" is famous as to clothing under 15 U.S.C. § 1125(c)(1).

10. Incontestable registration Registration No. 1,965,081 covers clothing items, including “wetsuits, swimwear, t-shirts, sweat shirts, sweat pants, jerseys, jackets, shirts, shorts, headwear, footwear, namely, surf bootees and dive bootees” in International Class 25.

11. The Application covers clothing items, “namely, pants, shirts, t-shirts, shorts, sweatshirts, jackets, gloves, hats, socks and headwear” in International Class 25.

12. The goods set forth in the Application are closely related to or identical to those in connection with which Opposer has used and is using his mark “XCEL”, including, but not limited to, the goods and services listed in Opposer’s registrations.

13. Certain goods covered by the Application are identical to the goods covered by Incontestable registration Registration No. 1,965,081 including: shirts, t-shirts, shorts, sweatshirts, jackets, and headwear.

14. The Application seeks registration of the mark “EXEL.”

15. Opposer’s registered mark, “XCEL”, and Applicant’s mark, “EXEL”, would be pronounced identically by many potential purchasers of clothing products.

16. Opposer’s registered mark, “XCEL”, and Applicant’s mark, “EXEL”, would be pronounced similarly by many potential purchases of clothing products.

17. Attached hereto as Exhibit “A” two pages printed from of Applicant’s website, <http://www.exel.fi/>.

18. On information and belief, Applicant is using its mark “EXEL” in the manner shown on Exhibit “A”.

19. The typeface used by Applicant as shown on Exhibit “A” is very similar to typefaces sometimes used by Opposer for his mark, “XCEL”.

20. Applicant's mark, "EXEL" so closely resembles Opposer's registered mark, "XCEL," that, if used in connection with the applied-for goods, it would be likely to cause confusion, mistake and/or deception of the relevant trade and public, to the damage of Opposer.

21. The use and registration of Applicant's mark, as indicated above, would result in confusion, mistake and/or deception as to the source or origin of Applicant's goods, leading consumers to believe that they are somehow affiliated with, approved, sponsored, or licensed by Opposer.

22. A likelihood of confusion exists under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) between Opposer's registered mark, "XCEL" and Applicant's mark, "EXEL".

23. If Applicant is permitted to use and register Applicant's mark for the goods specified in the Application, confusion in trade, resulting in irreparable damage and injury to Opposer, inevitably would result by reason of the similarity between Applicant's and Opposer's mark and the goods sold and provided thereunder. Any defect, objection, or fault found with goods marketed under Applicant's mark, "EXEL", would reflect on, and injure, the reputation Opposer has established for goods and services sold under his mark "XCEL".

24. If Applicant is granted the registration herein opposed, Applicant would obtain a *prima facie* exclusive right to use the mark set forth in the Application. Such registration would become a source of damage and injury to Opposer through the generation of confusion, mistake and/or deception, the dilution of Opposer's registered marks, and the diminution of Opposer's ability to control the quality of goods and services sold thereunder.

25. Moreover, such registration would run contrary to the requirement that all doubts as to the likelihood of confusion must be resolved in favor of Opposer, and against Applicant, who has a legal duty to select a mark totally dissimilar to marks already in use.

26. Applicant's mark as used on the goods listed in the Application, would dilute the distinctiveness of Opposer's mark "XCEL".

27. On information and belief, the goods covered by the Application are or will be offered to the same class of purchasers and users who purchase and use the goods and services in connection with which Opposer has used and is using his "XCEL" mark.

28. As indicated in paragraph 3 above, Opposer owns a service mark registration for his mark "XCEL" for retail stores.

29. Opposer's retail stores sell, among other things, sporting equipment, gloves and clothing items.

30. As stated previously, the Application covers "clothing; namely, pants, shirts, t-shirts, shorts, sweatshirts, jackets, gloves, hats, socks and headwear".

31. Applicant's clothing items overlap with the goods covered by the service mark registration for "XCEL" for retail stores.

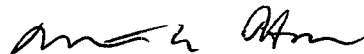
32. There is no issue as to priority. As evidenced by Opposer's registrations identified above, Opposer has been using his mark "XCEL" since at least as early as June 19, 1982.

33. On information and belief, Applicant has not used the trademark "EXEL" in commerce in the United States in connection with the applied for goods prior to filing the Application.

WHEREFORE, Opposer prays that this Opposition be sustained, that the Application be refused and the mark applied for therein refused registration. A duplicate copy of this Notice of Opposition and the fee required in 37 C.F.R. § 2.6(a)(17) are enclosed herewith.

DATED: Honolulu, Hawaii, January 21, 2003.

Respectfully submitted,

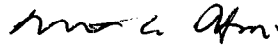


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Attorney for EDMONT P. D'ASCOLI, Trustee of
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LIVING TRUST DATED MAY 24, 1996

CERTIFICATE OF MAILING

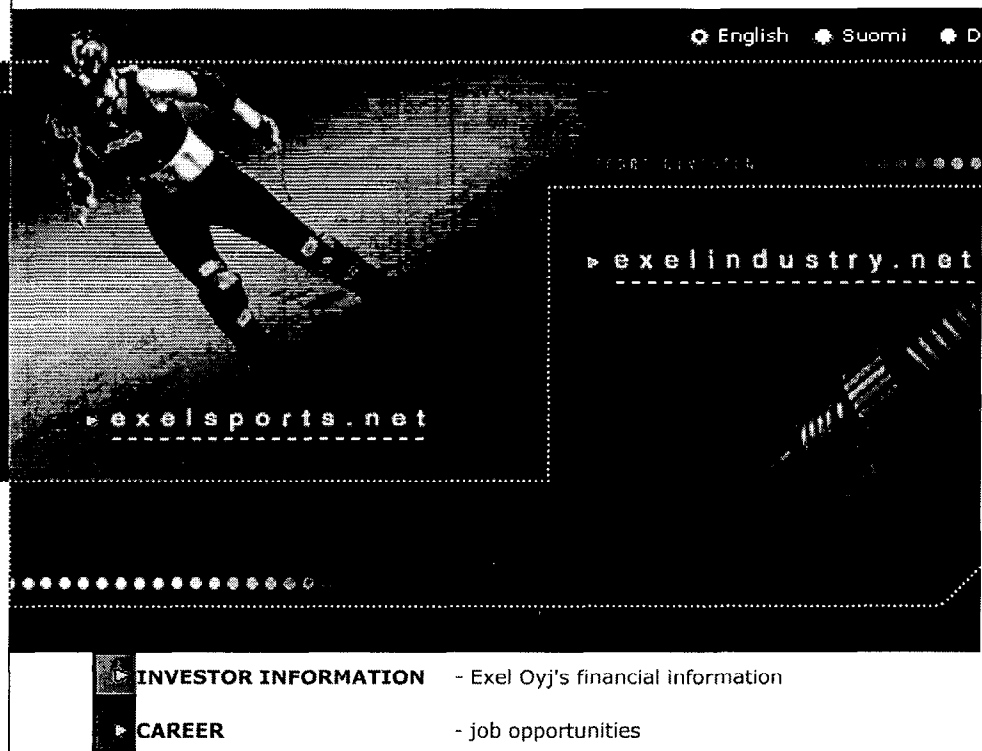
I HEREBY CERTIFY that this NOTICE OF OPPOSITION is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Box TTAB, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on January 21, 2003.




Martin E. Hsia




Exel Oyj is a technology company which designs, manufactures and markets composite sports equipment and industrial applications. Exel's operations comprise two divisions: Sport and Industry.





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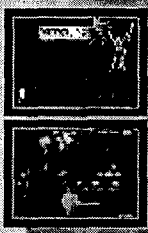


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SPORT

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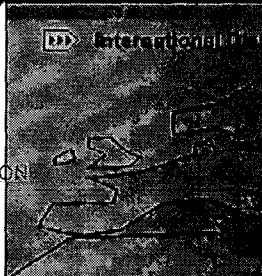
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